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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,561	10/28/2003	Michael J. Picciallo	P22,425-G USA	9169

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Synnestvedt & Lechner LLP
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Philadelphia, PA 19107-2950

EXAMINER

SHAH, AMEE A

ART UNIT	PAPER NUMBER
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3625

MAIL DATE	DELIVERY MODE
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07/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/695,561	Applicant(s) PICCIALLO, MICHAEL J.	
	Examiner Amea A. Shah	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 10-14 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 10-14 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-4, 7, 10-14 and 18 are pending in this action.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 7, 2007, has been entered.

Information Disclosure Statement

The information disclosure statement filed October 4, 2006, fails to comply with 37 CFR 1.98(b)(4) which requires each foreign patent or published foreign patent application listed in an information disclosure statement to be identified by the country or patent office which issued the patent or published the application, an appropriate document number, *and the publication date indicated on the patent* or published application. It has been placed in the application file, but the information referred to therein relating to the foreign patent application has not been considered. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Examiner Note

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7, 10, 11, 13, 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oncken et al., US 4,725,719 (hereafter referred to as "Oncken") in view of Nakano et al., US 5,845,260, cited by Applicant (hereafter referred to as "Nakano").

Referring to claim 1. Oncken discloses a method for transferring funds to third party dependents (see, e.g., Abstract), comprising creating an account for magnetic card access by a third party financially dependent upon a fund depositor, from which funds may be transferred at

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the request of said third party as a cash withdrawal or payment for goods or services purchased by said third party and transferring funds to said account and issuing a magnetic card to said third party for access to said funds (Fig. 3, col. 4, lines 11-27, col. 6, lines 53-61, and col. 8, lines 3-7 – note that the fund depositor, i.e. a user such as an employer, can transfer funds to the third party, i.e. an acceptor such as an employee who is financially dependent on the employer, through a magnetic card which can be used similar to a credit card to make purchases).

Oncken discloses restricting the third party as to which services and/or products the third party may purchase with the card, (col. 4, lines 19-27), but does not explicitly disclose prohibiting the spending of any amount of funds using the card on any one product, such as alcohol or tobacco.

Nakano discloses a method for using an interactive on-line service whereby a parent creates an account for his child with a limited maximum amount for services and the parent can restrict and prohibit certain services from being ordered by the child (e.g., col. 6, lines 47-57, col. 7, lines 16-18 and 42-51, and col. 8, lines 11-16). Nakano is concerned with the similar issue as Applicant in allowing a third-party, such as a child, unrestricted access to services the parent considers undesirable for the child, such as adult content movies (col. 7, lines 43-48). Nakano's solution for this issue is to prohibit any amount of funds using the account on such services (col. 7, lines 43-51 and col. 8, lines 11-16).

Oncken discloses restricting the use of the card to certain products, and Nakano discloses prohibiting use of the account for certain services/products. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of Oncken to include the teachings of Nakano to allow for the spending of any amount of funds

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using the card on alcohol or tobacco to be prohibited. Doing so would allow the parent to restrict and/or prohibit their money from being used on items, such as adult content movies, alcohol or tobacco, which the parent believes are unsuitable for the child, as suggested by Oncken (col. 3-12) and Nakano (col. 7, lines 48-51 and col. 8, lines 12-16).

Referring to claim 2. Oncken in view of Nakano further discloses the method of claim 1, further comprising the step of periodically and automatically transferring funds into said account in response to command instructions from said fund depositor (Oncken, col. 6, line 62 through col. 7, line 9, and col. 7, lines 65-68 – note that the account is automatically replenished when it reaches a certain value as commanded/agreed to by the fund depositor).

Referring to claim 3. Oncken in view of Nakano discloses the method of claim 1 comprising the further step of storing information on fund transferees and corresponding payment amounts for said account (Oncken, col. 7, lines 45-54); and supplying to said fund depositor through an output device said information on fund transferees and corresponding payment amounts for said account (Oncken, col. 7, lines 55-65).

Referring to claim 4. Oncken in view of Nakano further discloses the method of claim 1 wherein said funds are supplied to said account through a credit card network (Oncken, Fig. 4 and col. 6, line 63 through col. 7, line 15 and Nakano, Fig. 1, col. 3, line 51 through col. 4, line 7 and col. 8, lines 1-6).

Referring to claim 7. Oncken in view of Nakano discloses the method of claim 1 wherein said goods or services comprise books, computer software, food, lodging or entertainment (Oncken, col. 2, lines 32-50 and col. 7, lines 21-23 – note that goods or services purchased are inherently capable of being comprised of books, computer software, food, lodging or entertainment).

Referring to claims 10-11. Oncken in view of Nakano discloses the method of claim 3 wherein said information on fund transferees and corresponding payment amounts for said third party account is automatically supplied to said fund depositor (claim 10), and wherein said supplying step is performed periodically (claim 11) (Oncken, col. 7, lines 59-65).

Referring to claim 13. Oncken in view of Nakano further discloses the method of claim 2 wherein said funds are transferred weekly or monthly (Oncken, col. 7, lines 65-68 and col. 8, lines 3-7 and Nakano, col. 6, lines 47-51 – note that the fund depositor can periodically transfer money and set a monthly cash allowance).

Referring to claim 14. Oncken in view of Nakano further discloses the method of claim 1 wherein said financially dependent third party is a son or daughter of said fund depositor (Nakano, e.g. Abstract – note also that the method would be performed in the same fashion regardless of whether the third party is an employee or son or daughter of the fund depositor).

Referring to claim 18. Oncken in view of Nakano further discloses the method of claim 1 wherein said magnetic card is a debit card (Oncken, col. 2, lines 39-50 and col. 3, lines 18-29 – note that the invented method in Oncken discloses an improved method of which a debit card is prior art and one of the cards upon which the invention is an improvement).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oncken in view of Nakano and further in view of Hilt et al., US 5,465,206 (hereafter referred to as “Hilt”).

Referring to claim 12. Oncken in view of Nakano discloses the method of claim 3, as discussed supra, but does not explicitly disclose wherein said information is supplied via email.

Hilt discloses an electronic bill pay system wherein information is supplied via e-mail (col. 22, lines 41-45, “a message could be interchangeably embodied in a postal mail paper form, an e-mail message, a telephone voice response session, etc.” – note that a message includes information regarding transactions).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of Oncken in view of Nakano to further include the teachings of Hilt to allow for the information to be supplied via email. Doing so would result in a reduction of paper and increase in efficiency thereby resulting in increase in profits, as suggested by Hilt (col. 6, lines 19-21 and col. 20, lines 22-25).

Response to Arguments

Applicant's arguments filed May 7, 2007, have been fully considered but they are not persuasive. Applicant appears to attempt to overcome the 102(e) Nakano reference by showing prior invention to January 24, 1996 (Remarks, pages 2-4). However, applicant can only do this by filing an affidavit or declaration pursuant to 37 CFR 1.131 with the appropriate documentary evidence required (see, e.g., MPEP §§706.02(b) and 715). Furthermore, the Examiner notes that because the January 11, 1996, submittal did not contain a claim, it was not a complete non-provisional application and therefore was not entitled to the January 11, 1996, filing date (see 37 CFR §1.53 and MPEP §503) and constructive reduction to practice did not occur until April 16, 1996. Also, without documentation of what exactly was included in the January 11, 1996 submission, priority and/or conception cannot be attributed to that date. Therefore, claims 1, 2, 4, 7, 13 and 14 enjoy the priority date of April 16, 1996, but not January 11, 1996.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogesh C. Garg can be reached on 571-272-6756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

June 28, 2007


YOGESH C. GARG
PRIMARY EXAMINER
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